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09/523,503	03/10/2000	Michael A. Masini	MED-02702/29	4920

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John G Posa
Gifford Krass Groh Sprinkle Patmore
Anderson & Citkowski PC
280 N Old Woodward Avenue Suite 400
Birmingham, MI 48009

EXAMINER

ROBERT, EDUARDO C

ART UNIT	PAPER NUMBER
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3732

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24

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 24

Application Number: 09/523,503
Filing Date: March 10, 2000
Appellant(s): MASINI, MICHAEL A.

Mr. John G. Posa
For Appellant

EXAMINER'S ANSWER

MAILED
MAR 18 2004
GROUP 3750

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This is in response to the appeal brief filed December 22, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows:

The rejection of claims 12-15 under 35 U.S.C. 101 is withdrawn.

The rejection of claims 12-16 under 35 U.S.C. 112, second paragraph, is withdrawn.

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(7) Grouping of Claims

The appellant's statement in the brief that all of the rejected claims stand or fall with claim 8 is agreed with.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

4,474,177	WHITESIDE	10-1984
5,662,656	WHITE	09-1997

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 8-13, 15, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Whiteside (U.S. Patent No. 4,474,177). This rejection is set forth in prior Office Action, Paper No. 19.

Claims 8-13 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by White (U.S. Patent No. 5,662,656). This rejection is set forth in prior Office Action, Paper No. 19.

(11) Response to Argument

In response to applicant's argument that Whiteside is "entirely silent with regard to referencing *any* feature of the distal femur, regardless of whether such features include condyles or trochlear region" (see page 4, lines 22-23 of applicant's Brief), it is noted that Whiteside clearly shows in Figure 19 the fixture, which comprises member 81 and guide 80, referencing, i.e. refers to or indicate, the distal end 140 of the femur and where to cut at the distal end of the femur. Moreover, Whiteside's Figure 19 clearly shows that the fixture references to the trochlear

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region 143 (see Figures 14 and 19) since it slides along an axis between the condyles 141 and 142 of the femur, thus it indicates that area. Also, the guide 82, which is part of the fixture, indicates or refers to, as shown in Figure 19, the condyle areas, i.e. non-prominent and prominent, where a cut is done (see col. 9 lines 57-61).

In response to applicant's argument (see page 4, lines 23-26 of applicant's Brief) that "if Whiteside were to reference the non-prominent condyle or trochlear region, more bone would be removed from the most prominent condyle than the thickness of the prosthesis to be inserted, which is contrary to the statement" "The cutting guide surface 83 (not shown) is in position to remove the desired amount of bone (approximately the thickness of the distal portion of the femoral prosthesis component).", it is noted that applicant's way of reference to the distal femur is not the only way of "referencing". Moreover, the claims only require "references" to the non-prominent or trochlear region, they do not require "references" in a specific way and the term "references" has not been defined by applicant in any specific way. Moreover, as explained above, Whiteside clearly shows referencing to the distal femur, e.g. the non-prominent condyle, the prominent condyle, and the trochlear region, and this is reaffirmed when Whiteside states that "A saw blade 190 having saw teeth 192 is placed against cutting guide surface 83 (not shown) on the femoral side of the guide plate 82 and a rough cut of each of the two distal femoral condyles is made, one cut on each femoral side of guide plate 82." (see col. 9, lines 57-61), thus in order to make the cut the guide 82 must be referencing to the condyles as shown in Figure 19.

In response to applicant's argument that White's guide 91 "has nothing to do with measuring the distal extent of either condyle or the trochlear region." (see page 5, lines 14-16 of

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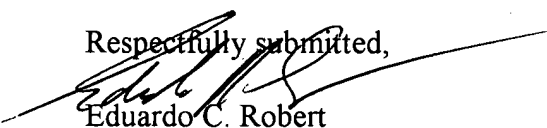
applicant's Brief), the limitations on which the Applicant relies are not stated in the claims.

Therefore, it is irrelevant whether the reference includes those features or not.

In response to applicant's argument that White discloses a guide 91 which cannot possibly contact the non-prominent condyle or trochlear region, it is noted that White disclose a fixture (see Figure 1), i.e. 11, which includes a movable member and cutting guide 113. The fixture clearly is mount or installed onto a distal femur (see Figures 11-18) and the fixture refers to or indicate the condyles at the end of the femur. Moreover, Figure 17 shows the fixture touching the non-prominent condyle region 29.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Eduardo C. Robert
Primary Examiner
Art Unit 3732

E.C.R.
March 15, 2004

Conferees
Mr. Kevin P. Shaver
Supervisory Patent Examiner
Art Unit 3732



Ms. Angela D. Sykes
Supervisory Patent Examiner
Art Unit 3762



JOHN G POSA
GIFFORD KRASS GROH SPRINKLE PATMORE
ANDERSON & CITKOWSKI PC
280 N OLD WOODWARD AVENUE SUITE 400
BIRMINGHAM, MI 48009